

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Young Wook LEE

Confirmation No.: 4169

Group Art Unit: 2615

Serial No.: 10/757,478

Examiner: Helen Shibru

Filed: 1/15/2004

Customer No.: 34610

For: METHOD FOR DISPLAYING INFORMATION OF DATA TO BE DELETED IN
DIGITAL VIDEO RECORDER

PRE-APPEAL BRIEF REQUEST FOR REVIEW

U.S. Patent and Trademark Office
Customer Service Window - **Mail Stop AF**
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

The Office Action rejects claims 1-4, 7-10, 15, 16, 18, 21 and 22 under 35 U.S.C. §103(a) over Kawasaki (U.S. Patent Publication Number 2003/0108328), in view of Tanikawa (U.S. Patent Number 6,515,950). For the reasons given below, it is respectfully submitted that the combination of Kawasaki and Tanikawa is improper, and that even the improper combination of these references fails to disclose or suggest all the features of these claims.

Kawasaki is directed to a digital video recorder. The Kawasaki digital video recorder operates such that after a file has been played to the user, the Kawasaki device causes a message to be displayed on the display screen asking if the user would like to delete the file which has just been played. This display is presented to the user at a time when no recording operation is being performed. The user can then manipulate a remote control to instruct the digital video recorder to delete a particular program file, or to indicate that the file should not be deleted.

Tanikawa discloses a method which could be used by a digital video recorder to overwrite program files which have already been played to a user at least once. The whole point of the Tanikawa methods is to automate the process of deleting old program files and replacing them with new program files which are overwritten onto the recording medium at locations from which the old files have been deleted.

Tanikawa discloses that information about each of the program files is recorded in a management area on the recording medium. This management information can include an indication of when the file was first recorded, an indication of when, if ever, the file has been played to the user, and whether the file has been "write protected." When the Tanikawa DVR is preparing to conduct a recording operation, the system checks to determine if there is sufficient free space on the recording medium. If so, the new file is recorded on the free space. If no free space is available, the system checks the management information for the files that are present on the recording medium. All program files that are not write protected, and that have already been played to the user at least once, are subject to being automatically overwritten by new program files. The Tanikawa system automatically overwrites those program files which are not write protected and which have already been played at least once, beginning with the file that is the oldest, in terms of when it was played to a user.

The Tanikawa methods allow a digital video recorder to automatically overwrite old program files without requiring the intervention of the user. To the extent the user wishes to write protect certain files, the user is free to do so. However, if new program files need to be recorded onto the recording medium, and certain old program files which have already been played to the user are available, the Tanikawa system will automatically overwrite the previously played files, starting with the oldest files first.

It is respectfully submitted that one of ordinary skill in the art would not have been motivated to modify the Tanakawa methods to incorporate any features of the methods disclosed in Kawasaki. Tanikawa specifically teaches that it is advantageous to automatically overwrite old files without

requiring any intervention from the user. As explained above, the Kawasaki digital video recorder requires active participation by the user, using an on screen display and a remote controller, to manually select those files which are to be deleted or overwritten. If one were to modify the Tanikawa methods to incorporate the Kawasaki on screen displays which are used to manually select files for deletion, this modification would destroy the entire purpose of the Tanikawa methods. In other words, if one were to modify the Tanikawa methods to force the user to interact with the recorder to select files for deletion, the Tanikawa digital video recorder would no longer be automated, and the entire purpose of the Tanikawa methods would have been destroyed.

For at least the above reasons, it is respectfully submitted that one of ordinary skill in the art would not have modified the Tanikawa methods to incorporate the display and interaction steps disclosed in Kawasaki. It is respectfully submitted that it requires the impermissible use of hindsight, in view of Applicants' invention, to find a motivation to selectively combine Tanikawa and Kawasaki as asserted in the Office Action. Accordingly, it is respectfully submitted that the combination is improper, and that the rejection should be withdrawn on these grounds alone.

Moreover, even if one were to improperly combine the Tanikawa and Kawasaki references, the improper combination would still fail to disclose or suggest all the features of certain of the rejected claims.

For instance, claim 3 recites displaying management information of data to be deleted from a storage medium during a data overwriting operation in the form of an onscreen display. Claim 3 further recites that the onscreen display image includes a mark identifying a position of the data file to be deleted. As explained in the present application, the mark would provide an indication about where on the actual physical recording medium the data file to be deleted is located. Claim 4 depends from claim 3 and further recites that the onscreen display also includes a mark identifying a position of the video image data that is currently being recorded on the recording medium in the recording operation.

The Office Action suggests that Kawasaki discloses displaying a mark identifying a position

where a data file is to be deleted, or that the onscreen display includes a mark identifying a position of video image data that is currently being recorded. The Office Action points to images such as that shown in Figure 1A of Kawasaki, which provides a listing of all of the data files recorded on the recording medium, wherein the list is provided in a particular order. It is respectfully submitted that listing program data files in a particular order does not provide any indication about where those files are actually recorded on the recording medium itself. Furthermore, because Kawasaki is not conducting a recording operation at the time that Kawasaki system provides an onscreen display, the onscreen display is necessarily not indicative, in any fashion, of where data is currently being recorded during a recording operation.

Claim 8 recites that the management information which is displayed to a user is information of the data file recorded on the storage medium at a position spaced apart by a predetermined distance from a current recording position of the storage medium. In other words, claim 8 recites that management information is displayed for a file which is recorded at a location on the physical recording medium that is spaced apart from the current recording position on the physical recording medium by a predetermined distance. Claim 9 depends from claim 8 and recites that the predetermined distance is determined by at least one of the control signal and a selection made by a user. Claim 10 also depends from claim 7 and recites features similar to those in claim 8. Nothing in either Tanikawa or Kawasaki disclose or suggest displaying management information for a file that is recorded on the recording medium at a position that is located a predetermined distance from the current recording position on the recording medium, nor any of the additional features in claim 9.

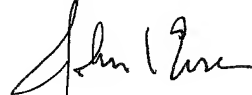
Claims 21 and 22 depend from claims 15 and 18, respectively, and include features similar to those discussed above in connection with the other dependent claims – features which are not present in Tanikawa and Kawasaki.

For all of the above reasons, it is respectfully submitted that the dependent claims are also allowable over even the improper combination of Kawasaki and Tanikawa.

In view of all the foregoing, it is respectfully submitted that the rejection of claims 1-4, 7-10, 15, 16, 18, 21 and 22 over Kawasaki and Tanikawa is improper and should be withdrawn.

The Office Action rejects claims 5 and 6 under 35 U.S.C. §103(a) over Kawasaki, in view of Tanikawa, and further in view of Applicant's admitted prior art. The Office Action also rejects claims 11-14, 17 and 23 under 35 U.S.C. §103(a) over Kawasaki, in view of Tanikawa, and further in view of Cochran (U.S. Patent Publication Number 2004/0024838). The Office Action further rejects claims 19 and 20 under U.S.C. §103(a) over Kawasaki, in view of Cochran, and further in view of Tanikawa and Applicant's admitted prior art. As explained above, it is respectfully submitted that the combination of Tanikawa and Kawasaki is improper. For at least this reason, it is respectfully submitted that these additional rejections are improper and should be withdrawn.

Respectfully submitted,
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